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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/050,900 | 01/16/2002 | Donald P. McGee | 088223-9036-01 | 5836 |

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| EXAMINER | |
|---|---|
| SIPOS, JOHN | |
| **ART UNIT** | **PAPER NUMBER** |
| 3721 | |

DATE MAILED: 04/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/050,900 | MCGEE ET AL. | |
| | Examiner | Art Unit | |
| | John Sipos | 3721 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the corresp ndence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *29 November 2003*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *8-23* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *8-11,13-20,22 and 23* is/are rejected.

7)☒ Claim(s) *12 & 21* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

## *REJECTIONS OF CLAIMS BASED ON PRIOR ART*

**Claims 8,9,13-17,20,22 and 23** are rejected under **35 U.S.C. ' 103(a)** as being unpatentable over the patent to Umetsu (5,191,693) or Bird (5,729,963) in view of Tuns (4,1298,166) or Otto (2,899,783). The patents to Umetsu and Bird show a support for a carrier tape (machine frame which inherently supports the tape), advancing means (12 and 209/211,respectively) for the tape, pick-up-place means (H and 210, respectively) for placing articles in the compartments of the tape and inspection means (20 and column 5, line 18 et seq. respectively). These references lack the use of vibrating means to settle the products in the compartments. The patents to Tuns and Otto show packaging machines which comprise conveying paths (6 and 36, respectively) for moving containers past a filling mechanism (7 and 18, respectively) and vibrating means (14 and 46, respectively) under the conveying path that vibrates the containers to settle the products through a transferring member (13 and 36a, respectively). It would have been obvious to one of ordinary skill in the art to provide the machines of Umetsu or Bird with a vibrating means as shown by Tuns or Otto to vibrate and settle the articles in the compartments. The specific type of vibrating means (claims 14,15,20,22 and 23) are well known and their use in the Umetsu or Bird machines would have been obvious to one of ordinary skill in the art to settle the articles.

**Claims 10,11,18 and 19** are rejected under **35 U.S.C. ' 103(a)** as being unpatentable over the patent to Umetsu and Bird in view of Tuns or Otto as applied to the claims above, and further in view of the patent to Sato (5,943,211). The combination of references does not show a vibrator with an eccentric weight. The patent to Sato shows a vibrating mechanism comprising a

motor 1 with an output shaft and an eccentric weight 6 on the shaft to vibrate the motor (column 11, line 37 et seq.). it would have been obvious to one of ordinary skill in the art to substitute the vibrator of Sato for the vibrator of the Umetsu or Bird combination to settle the articles in the compartments.

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## *ALLOWABLE SUBJECT MATTER*

**Claims 12 and 21** are objected to as being dependent upon a rejected base claim, but **would be allowable if rewritten in independent form** to include all of the limitations of the base claim and any intervening claims.

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## *RESPONSE TO APPLICANT'S ARGUMENTS*

Applicant's argument that prima facie case of obviousness has not been established are not persuasive. To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

In response to Applicant's argument that there is no suggestion to combine the references, the Examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. In re Nomiya, 184 USPQ 601 (CCPA 1915). However, there

is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures take as a whole would suggest to one of ordinary skill in the art. In re McLaughlin, 110 USPQ 209 (CCVA 1971). References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. In re Bozek, 163 USPQ 545 (CCPA. 1969. In this case, the secondary references to Tuns and Otto teach the use of devices that induce vibration in containers during the filling operation to aid in the settling of the products within the container. These references clearly teach this concept in the packaging art and this suggestion provides the motivation to combine their teachings with either of the basic references to Umetsu or Bird.

In response to Applicant's argument that the secondary references to Tuns and Otto teach away from the suggested combination is also not persuasive. Applicant's main argument seems to be that these references teach away from the combination in that they are directed to densifying powder and settling nails, respectively, and not to settling parts into compartments. The specific product to which these references are directed is of little importance. It is what these references teach as a whole that should be considered. In each case, the machine disclosed by the references teach the use of mechanism that vibrate the containers to settle the product within the containers. Furthermore, these references are considered to be analogous art since they are within the field of the inventor's endeavor and they are reasonably pertinent to the particular problem with which the inventor was involved. *In re Wood*, 202 USPQ 171, 174.

In response to Applicant's argument that the Examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so

long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. *In re McLaughlin*, 443 F.2d 1392; 170 USPQ 209 (CCPA 1971). As was stated above, the secondary references teach the particular problem with which the inventor was involved and a solution to the problem. The settling of products in a packaging machine is performed by the prior art in the same manner as by applicants. In both instances the packaging machine is provided with a vibrating mechanism that produces vibrations in the containers and products and settles the products within the container. Since this is taught by the applied art, no hindsight was used in making the rejections.

In response to Applicant's argument that the combination of references would not have a reasonable expectation of success, it is pointed out that a person skilled in the art would accommodate and design a vibrating mechanism such as taught by the secondary references to properly operate in the machines of either of Umetsu or Bird. The specific type of containers, the specific type of products and the required vibrating force would all be obvious modifications to the person skilled in the art.

Finally, as stated above, the prior art reference (or references when combined) teach or suggest all the claim limitations. The patents to Umetsu or Bird teach the basic structure of the machine except for the vibrating mechanism and the secondary references to Tuns and Otto teach the vibrating mechanism operating for the same purpose as applicants. The teaching of these references when combined suggest all the claimed limitations.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication should be directed to **Examiner John Sipos** at telephone number **(703) 308-1882.** The examiner can normally be reached from 6:30 AM to 4:00 PM Monday through Thursday.

The **FAX** number for Group 3700 of the Patent and Trademark Office is **(703) 305-3579**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Peter Vo, can be reached at (703) 308-1789.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group Receptionist whose telephone number is (703) 308-1148.

**John Sipos**
**Primary Examiner**
**Art Unit 3721**